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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,203	02/23/2004	Dylan Van Atta	NIKE.135838	8831
5251	7590	04/08/2008	EXAMINER	
SHOOK, HARDY & BACON LLP			MORAN, KATHERINE M	
INTELLECTUAL PROPERTY DEPARTMENT			ART UNIT	PAPER NUMBER
2555 GRAND BLVD			3765	
KANSAS CITY, MO 64108-2613			MAIL DATE	DELIVERY MODE
			04/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/785,203	<b>Applicant(s)</b> ATTA ET AL.
	<b>Examiner</b> Katherine Moran	<b>Art Unit</b> 3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 March 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 13-19,33-39,44-47,55-59,61-64 and 66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 18,19,33-39,44-47,59,61-64 and 66 is/are allowed.
- 6) Claim(s) 13-17 and 55-58 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 July 2007 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-646)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No./Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No./Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/22/08 has been entered. Applicant submitted an amendment to claims 13, 18, 33, 37, 44, 59, 61, and 64. This amendment has overcome the 35 USC 112, 1<sup>st</sup> par rejections. Claims 13-19, 33-39, 44-59, 61-64, and 66 are pending.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 13-17 and 55-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Banks (U.S. 6,131,208). Banks discloses the invention as claimed. Banks teaches swim goggles comprising a pair of unconnected eyepieces, each eyepiece comprising a transparent lens 3, frame or body portion 1 surrounding the lens and having a posterior surface, and peripheral flange 5 surrounding the lens portion and peripheral wall. The flange is sized and shaped to fit at least partially within a respective

orbital rim and the lens portion positioned in front of an eye when the eyepiece is worn. The flange also includes an upper nasal portion and a lower nasal portion on an inner side that fit within a respective orbital rim and also includes a lower temporal portion on an opposing side that fits at least partially within a respective orbital rim. Each eyepiece is adapted to provide a water-tight seal around an eye of a user during use of the goggles, wherein each eyepiece has a minimum depth about 5.75 mm or less, or of less than 8 mm measured at locations above and below the eyes when the eyepieces are in an as worn orientation. The recitation of "a minimum depth of less than 8 mm measured at locations...in an as worn orientation" is functional in that it does not recite the structural dimensions of any specific portion of the eyepiece. It is noted that pages 10-11 of Applicant's specification discuss the depth of the eyepieces as measured from the inner surface of the anterior lens and the temporal end of the anterior lens. As currently presented, claim 13 conveys that the depth of the eyepiece is determined by the dimensions of the wearer's eye as well as by the positioning of the eyepiece in relation to the wearer's eye portions. For example, if the eye socket or orbital bones are deeper-set, then the depth of the eyepiece will likely be smaller when measured at locations above and below the eyes. Banks is silent with regard to the depth of the frame portion, but the domed shape of the frame fits over a wearer's eye and appears to have a minimum depth of 5.75 mm or less. The domed shape allows for covering the eyes without interfering with the wearer's eye blinking capabilities. Each eyepiece includes a layer of adhesive tape 5 for adhesively securing the eyepiece to the skin. Each layer of tape comprises a deformable layer that is secured to the posterior surface

4 of a respective frame and has an adhesive surface for adhering to the skin. The eyepieces can be retained in place by contracting the orbicularis oculi muscles against the frame portions.

***Allowable Subject Matter***

4. Claims 18,19, 33-39, 44-47, 59, 61-64, and 66 are allowed.

***Response to Arguments***

5. Applicant's arguments filed 3/19/08 have been fully considered but they are not persuasive. Applicant submits that Banks does not teach an adhesive that secures the eyepiece to the skin of a user to form a water-tight seal around the eye. The Examiner's position is as follows: Banks' double-sided adhesive is described as a medical grade adhesive material that provides secure adhesion to the skin but is easily removed when necessary without injury to the skin surface. Applicant's specification discloses the double-sided adhesive tape material of the present invention could be made from Bioflex TM which is a medical grade pressure sensitive adhesive material providing desired adhesion, yet is easily removed from the skin without irritating the skin layer. Thus, Applicant's adhesive appears to be equivalent to that taught by Banks since Applicant has not further defined the structure or composition of the adhesive material to define over Banks' adhesive. Therefore, since Banks' adhesive is structurally equivalent to the claimed adhesive, Banks' adhesive is expected to perform in the same manner, i.e. to provide a water-tight seal.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch, may be reached at (571) 272-4996. The official and after final fax number for the organization where this application is assigned is (571) 273-8300. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 28, 2008

/Katherine Moran/

Primary Examiner, Art Unit 3765